



Paper No. 6

COPY MAILED**AUG 7 2001**LERNER & GREENBERG PA
P O BOX 2480
HOLLYWOOD, FL 33022-2480In re Application of
Rast and Kuhn
Application No. 09/511,815
Filed: February 24, 2000
Attorney Docket No. GR 99 P 4036
For: ELECTRO-OPTICAL MODULEOFFICE OF PETITIONS
DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)
AND
DECISION ON PETITION UNDER
37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.47(a), filed July 16, 2001.

This is also a decision on the petition under 37 CFR 1.137(b), filed July 16, 2001 to revive the above-identified application.

The petition under 37 CFR 1.47(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a) and Renewed Petition Under 37 CFR 1.137(b)."

This above-cited application became abandoned for failure to respond in an appropriate and timely manner to the "Notice to File Missing Parts of Non-Provisional Application" (the "Notice") mailed May 11, 2000, which indicated that a declaration complying with 37 CFR 1.63 was missing and that a surcharge of \$130.00 was due, consequently. The Notice set forth an extendable shortened statutory period for reply of two months. No response was received within the allowable period and the application became abandoned on July 12, 2000.

Consideration under 37 CFR 1.47(a)

On July 16, 2001, petitioner filed the present petition under 37 CFR 1.47(a), a "Combined Declaration for Patent Application and Power of Attorney", and remitted the surcharge due because of the late filing a proper declaration. The petition was accompanied by a Declaration in Support of Petition Under 37 CFR 1.47 (a) as offered by Ms. Denise Lettau, an employee of the above-cited firm, and was also accompanied by other evidentiary documents. The declaration of Ms. Lettau indicates that the German counsel, Maikowski and Ninnemann, retained by the assignee to assist in the prosecution of the above-cited patent application was unable to locate inventor Rast after diligent efforts. Copies of correspondence between the above-cited firm and the German counsel were also provided.

A grantable petition under 37 CFR 147(a) requires:

- (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and,

- (4) a statement of the last known address of the nonsigning inventor.

Petitioner lacks item (1) above.

As to item (1), 37 CFR 1.47(a) provides that an application for patent may be made by the other named inventors on behalf of themselves and the non-signing inventor if, among other requirements, proof of the pertinent facts surrounding the alleged refusal is provided. Section 409.03(d) of the *Manual of Patent Examining Procedure* provides guidance as to what is sufficient proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers. This section states, in pertinent part, as follows:

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventors' attorney.

The instant petition was not accompanied by any evidence that petitioner made a bona fide attempt to present a copy of the application papers to the non-signing inventor. The correspondence accompanying the petition only reveals that the application papers were sent to the assignee, but never to the non-signing inventor at his last known address as required.

Further, petitioner has not properly demonstrated that a 'diligent' effort was made to locate the non-signing inventor. The *Manual of Patent Examining Procedure*, Section 409.03(d) and provides, in pertinent part, as follows:

Where inability to find or reach a non-signing inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc. that support a finding that the non-signing inventor could not be found or reached should be part of the affidavit or declaration. It is important that affidavit or declaration contain statements of facts as opposed to conclusions.

Petitioner is cautioned that the affidavit or declaration of facts offered to support the petition under 37 CFR 1.47 must be signed, where possible, by a person having firsthand knowledge of the facts recited therein. It appears that the German counsel made the effort to locate the non-signing inventor. As such, a statement as to the diligent efforts made to locate the nonsigning inventor should be provided by a representative of Maikowski and Ninnemann. Because the recitation of facts concerning the efforts to locate the non-signing inventor are not offered by a representative of the German counsel, the recitation of facts is tantamount to hearsay because the facts are offered by a person having second-hand knowledge of the information provided therein. Where at all possible, a petition filed under 37 CFR 1.47 will not be granted based on hearsay statements. It cannot be said that petitioner has provided sufficient proof to warrant the prosecution of the above-cited application without the non-signing inventor because the instant petition lacks sufficient proof that diligent efforts were made to locate the non-signing inventor and there is no indication that the complete application papers were sent to the non-signing inventor.

Consideration under 37 CFR 1.137(b):

Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for

failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue

fee or any portion thereof, the required reply must be the payment of this issue fee or any outstanding balance thereof.

- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d) required pursuant to 37 CFR 1.137(c).

The present petition does not satisfy item (1).

As to item (1), petitioner has failed to submit the required reply to the Notice of May 11, 2000. Petitioner must either file a declaration signed by all of the inventors or a grantable petition under 37 CFR 1.47(a).

Conclusion

Any request for reconsideration of this petition under 37 CFR 1.47(a) should provide proof that the application papers were sent to the non-signing inventor at his last known address and a declaration of facts describing the efforts to locate the non-signing inventor attested to by a representative of Maikowski and Ninnemann. Alternatively, petitioner may file a declaration in accordance with 37 CFR 1.63 that is properly executed by both named inventors.

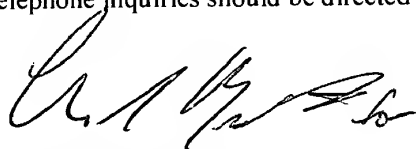
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6919
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
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Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.



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